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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,018	11/14/2003	Simon Pizzoli	GB920030026US1	1974
23550 7590 01/14/2008 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER NGUYEN, PHILLIP H	
			ART UNIT 2191	PAPER NUMBER
			NOTIFICATION DATE 01/14/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

## Office Action Summary

Application No.

10/714,018

Applicant(s)

PIZZOLI ET AL.

Examiner

Phillip H. Nguyen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 11/13/2007.
2. Claims 1, 10 and 19 have been amended.
3. Claims 1-20 remain pending and have been considered below.

#### ***Response to Amendment***

4. The rejection to claims 1, 10 and 19 under 35 USC 112, first paragraph of previous office action is withdrawn in view of Applicants' amendment.
5. The rejection to claims 1, 10 and 19 under 35 USC 112, second paragraph of previous office action is withdrawn in view of Applicants' amendment.
6. The rejection to claims 19 and 20 under 35 USC 101 of previous office action is maintained in view of Applicants' amendment.
7. The rejection to claims 1-6, 8-15 and 17-20 under 35 USC 102(b) of previous action is maintained in view of Applicants' amendment.
8. The rejection to claims 7 and 16 under 35 USC 103(a) of previous office action is withdrawn in view of Applicants' amendment.

#### ***Response to Arguments***

9. Applicant's arguments filed 11/13/2007 have been fully considered but they are not deemed persuasive.

Applicants assert on pages 9-10 of the amendment regarding claims 1, 10 and 19 that Halviatti fails to teach *script translation means for intercepting a call from the automation script to a function simulating a user action on the application while protecting the application's natural run-time execution*. Applicant further asserts that Halviatti relies on the specific interception of the running application to achieve its goals, therefore not protecting the application's natural run-time execution, including the need to write ATUs (Application Translation Units), which are not necessary in the claimed invention.

Examiner respectfully disagrees with all the allegations as argued. Firstly, Halviatti teaches "... *the target application is registered with the Message Engine 350. In particular, hooks are installed by a corresponding ATU 340 so that events within the target application of interest are trapped*" (See col. 10, lines 43-47). In other words, Halviatti uses hooks to intercept calls. No where in Halviatti's approach teach, relies on the specific interception of the running application to achieve its goals. Secondly, *intercepting a call* as recited in the independent claims can be interpreted as *specific interception or not specific interception* (See at least col. 9, lines 17-19). The claimed limitation does not limit to any kind of interception. Thirdly, Halviatti teaches "*general system events, that is, ones not specific to any particular application, may be processed by the CBT system 300 as well*" (See at least col. 9, lines 17-19). In other words, Halviatti's approach is not only rely on the specific interception of the running application to achieve its goals but it also relies on none specific interception and therefore it's protecting the application's natural run-time execution. Even assuming that Halviatti

relies on the specific interception of the running application to achieve its goals, Applicants cannot assume that Halviatti's interception is not protecting the application's natural run-time execution by saying that Halviatti's approach relies on the specific interception to achieve its goals. Lastly, if the Applicants believe that Halviatti's interception is not protecting the application's natural run-time execution, the Applicants need to show more evidences.

Applicant further asserts on page 10 of the amendment regarding claims 2, 11 and 20 that Halviatti fails to teach *selective text locator means coupled to the message translation means for selectively supplying appropriately translated text to the automation script's run time execution depending on the function call in a case that a same text string is translated based on context* because a general call to translate a message in a Window environment is not equivalent to selecting an accurate text translation from a plurality of available translations (not in the claims).

Examiner respectfully disagrees with the allegation as argued. Firstly, the claimed limitation is limited to one available translation (i.e. supplying appropriately translated text). Secondly, a call to GetMessage() to retrieve a translated message is equivalent to supplying appropriately translated text. Finally, even assuming that the translated text is selected from a plurality of available translations, Halviatti teaches that the TranslateMessage() function translates messages from a queue (See col. 7, lines 55-67 - col. 8, line 1). In other words, GetMessage() returns a translated message from a plurality available messages from a queue.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1] Interpretation of Claims-Broadest Reasonable Interpretation. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification.

Applicants always have the opportunity to amend the claims during the prosecution and broad interpretation by the examiner reduces the possibility that the claims, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 16 contain the trademark or trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark or trade name is used to identify or describe a family of

products generated in the proprietary programming language called JAVA and accordingly, the identification or description is indefinite.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 and 20 are rejected under 35 U.S.C. 101 because claim rejected under 35 U.S.C. 101 because: Although, Applicants have amended claim 19 to recite "tangible computer readable storage medium", but the specification provides intrinsic evidence that this tangible computer readable storage medium can also include data carrier. Applicants are suggested to amend the specification paragraph [0079] to include "...a computer program element carried on any suitable data carrier or computer readable storage medium, such as a magnetic or optical computer disc" and amend claim 19 to recite "computer readable storage medium" to overcome the rejection.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Halviatti et al (US Patent No.: 5,475,843).

As per claims 1, 10 and 19:

Halviatti discloses:

- automation script means for receiving an automation script for automating use of the user interface in an application ("**sends appropriate script scenes to the Script Engine**" col. 10, lines 36-37; **also see for example, FIG. 6, and texts which further expand their features** col. 21, lines 35-46); and
- script translation means for intercepting a call from the automation script to a function simulating a user action on the application while protecting the application's natural run-time execution ("**Message Engine may trap each CreateWindow API call for determining each screen object which is about to be created**" col. 24, lines 33-35), retrieving a translated text string associated with the function call ("**retrieved by a call to GetMessage(...)**" col. 7, lines 55-62), and calling the function simulating the user action with the translated text string ("**class methods are provided for simulating user events. For instance, the Click(), DbClick()...**" col. 33, lines 25-30; "**user interaction simulation, and Resource tracking**" col. 34, line 16; "**Each GEM can simulate any possible operation that a user would perform on any given element...**" col. 35, lines 38-44).



As per claims 2, 11 and 20:

Halviatti discloses:

- message translation means for supplying translated text for the automation script's run time execution ("**TranslateMessage()**" col. 7, line 64; "**ATUs translate low-level messages into high-level messages**" col. 22, lines 39-40); and
- selective text locator means ("**GetMessage()**" – **a message is retrieved by a call to GetMessage()**" col. 7, line 61; **retrieving a message/text is the same as locating a message/text**) coupled to the message translation means for selectively supplying appropriate text to the automation script's run time execution depending on the function call ("**the retrieved message may be translated by a call to TranslateMessage**" col. 7, lines 63-64).

As per claims 3 and 12:

Halviatti discloses:

- wherein the selective text locator means is arranged to selectively supply appropriate text to the automation script's run time execution depending on a resource ID of the function call ("**an unique id is constructed for this top level menu...the resource database is search for the record under this id...the tope level menu string from the menu handle is retrieved...a preferred name is also retrieved...**" col. 37, lines 4-10).

As per claims 4 and 13:

Halviatti discloses:

- a library ("**GEM Library**" col. 31, line 21, **a collection of GEMs**) including a function having the same signature as the function call and which is arranged to retrieve the translated text string before the function call ("**a GEM encapsulates the behavior of irreducible user interface elements such as push buttons, checkboxes, listboxes, menu items...when GEM is instantiated, it takes two parameters...the GEM can be instructed to run a self test method by simple comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)**" col. 31, line 60 – col. 32, lines 1-60); and
- one of a file ("**a GEM**" col. 31, line 43) referencing the library ("**when a GEM instantiated, it takes two parameters: a reference to its parent and...**" col. 31, lines 52-44; **a GEM is also considered as a file or a program, it references to its parent, a library**), the automation script being arranged to reference the file and the library ("**Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded...**" col. 41, lines 15-20; which means, when the a test script is being tested, the GEM library classes gets called), and the library including the retrieval function ("**self test method is comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)**" col. 31, lines 51-

55) and the function call ("**a GEM ... a reference to its parent**" col. 31, lines 43-44, **a call to its parent**) , the library being arranged to be called by the automation script ("**Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded...**" col. 41, lines 15-20; **which means, when the a test script is being tested, the GEM library classes get called**).

As per claims 5 and 14:

Halviatti discloses:

- wherein the file referencing the library comprises an include file ("**Appendix E: Window Proxy**" col. 49).

As per claims 6 and 15:

Halviatti discloses:

- wherein the library including the retrieved function and the function call has the same name as a library containing the function called by the automation script ("**GEM Library**" col. 31, line 21; **GEM Library including retrieved function and function call disclosed above and is called by automation script upon invocation of a test script**).

As per claims 7 and 16:

Halviatti discloses:

- wherein the automation script comprises a script (see at least col. 10, line 36 **"script"**).

As per claims 8 and 17:

Halviatti discloses:

- wherein the automation script is in the English language and the application is arranged to use a non-English language ("**a lingua franca or common language for all events**" col. 9, lines 20-22).

As per claims 9 and 18:

Halviatti discloses:

- wherein the user interface comprises a graphical user interface (**FIG. 1, and text, which further expand their features**, col. 5, line 51).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12/28/2007

  
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